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MAR 06 2009
TECHNOLOGY CENTER 3600

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In re Application of	:	
Gary M. Katz	:	DECISION ON PETITION UNDER
Application No. 09/828,122	:	37 C.F.R. 1.181 TO
Filed: April 9, 2001	:	WITHDRAW FINALITY
For: PAIRED PROMOTION ARCHITECTURE	:	

This is in response to applicant's Petition filed on December 20, 2008, requesting withdrawal of the finality of the Office action mailed December 5, 2008 as being premature.

The petition is **GRANTED to the extent indicated below.**

Petitioner alleges that the final rejection dated December 5, 2008 was premature since this Office action contained a new grounds of rejection not necessitated by applicant's amendment or by new information submitted in an information disclosure statement.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

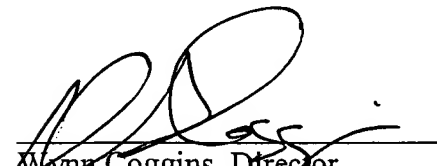
A review of the record indicates that in the final rejection dated December 5, 2008, claims 1-19, 24 and 26-28 were for the first time rejected under 35 USC 101 as being directed to non-statutory subject matter based on an In re Bilski analysis, which rejection was not in response to an amendment or new prior art submitted by applicant, but instead a policy change by the Office.

Accordingly, the finality of the December 5, 2008 Office action, but not the action itself, is hereby vacated. The Office action dated December 5, 2008 is now considered to be non-final with the shortened statutory period of THREE (3) MONTHS set in the Office action.

Note, the rejection of newly introduced claims 59-64 under 35 USC 112, first paragraph, as failing to comply with the written description requirement, under 35 USC 112, second paragraph, as being indefinite, and under 35 USC 102(b) as anticipated by Deaton et al., is not considered premature. These claims were first introduced in the amendment filed December 27, 2005. The

Examiner proceeded to issue the election by restriction (election by original presentation) requirement (on March 27, 2006) which was the subject of the Petition decision issued October 20, 2008. This decision caused the Examiner to step back in time to the December 27, 2005 amendment where these claims were first introduced. Thus, the rejections of claims 59-64 was "as necessitated by amendment".

Summary: *Petition Granted*


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EWS: 3/4/09

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